RESPONSE AND REMARKS

I. REJECTIONS UNDER SECTION 103(a)

In the Office Action, Claims 64-67 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kara et al. (U.S. Patent No. 6,233,568; "*Kara*") in view of InterShipper; (Newsbytes Article, Internet Update; "*InterShipper*"), UPS® On Call Air Pickup (www.apps.ups.com; "*UPS On Call*"), UPS® Service Guide (www.ups.com; "*UPS*") and FedEx® Services (www.fedex.com; "*FedEx*"). *Office Action*, Topic No. 4, p. 3.

In the Office Action, Claims 68-79 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kara* in view of *InterShipper*, *UPS On Call*, *UPS* and *FedEx* as applied to claim 64 above, and further in view of Barnett et al. (U.S. Patent No. 6,369,840; "*Barnett*"). *Office Action*, Topic No. 9, p. 4.

II. RESPONSE REMARKS REGARDING SECTION 103(a) REJECTIONS

The rejections under Section 103(a) have been carefully considered.

As mentioned above, Claims 64, 67, 69, 72, 74 and 77 have been amended to more distinctly claim the claimed invention; Claims 68, 71, 73, 76 and 78-79 have been cancelled; new dependent Claims 80 and 81 have been added.

Reference is made herein to a previously-filed Declaration under 35 U.S.C. §132 by David Allison Bennett (filed on April 9, 2009 with Applicants' Amendment and Response to the Office Action dated December 10, 2008), currently with iShip Inc. (a fully owned subsidiary of United Parcel Service of America, Inc., which is a fully owned subsidiary of United Parcel Service, Inc.), one of the assignees of the above-identified patent application ("*Bennett Declaration*" or "*Bennett Decl.*").

A copy (marked "COPY") of the Bennett Declaration is enclosed with this filing for convenience of reference.

It is respectfully asserted, for the reasons given and authorities previously given (which are incorporated in full by reference herein) and further for the reasons given and authorities cited below, and in view of the evidence provided by the *Bennett Declaration* supporting the assertions herein of non-obviousness, that the claimed invention is not

disclosed, anticipated, taught or suggested by the cited references and that the application is therefore in condition for allowance.

A.   *The Apparent Interpretation By the Office Action of the Claimed Term "According to" is Contrary to the Ordinary Meaning of the Term.*

The Office Action asserts that the Specification of the present application does not support the claimed limitation that shipping rates are calculated *according* to the claimed user's input comprising, among other things, a shipping date. *See Office Action*, Topic No. 16, p. 8. However, the Office Action then explains that the Specification discloses that "the shipping date is used to determine the delivery date, and if the delivery date is on a Saturday or Sunday, then the rate is adjusted accordingly." *Id.* The Office Action further explains that "the shipping rate is not determined according to the shipping date[;] the shipping rate is determined according to the delivery date." *Id.*

As compared to the Office Action's assertion that the Specification does not support the claimed limitation, it is respectfully asserted that the aforementioned reasoning expressed by the Office Action actually demonstrates that the Specification discloses that the claimed calculation of shipping rates is done according to, among other things, a shipping date. That is because, as asserted by the Office Action, the Specification discloses that a shipping rate is calculated according to a delivery date; and the delivery date is determined according to a shipping date (and, in some instances, a pickup time); the calculation of a shipping rate, according to the Office Action's own admission, is therefore a consequence of, and a natural sequence of, the determination of a delivery date, which is, in turn, according to the Office Action's own admissions, a consequence of, and a natural sequence of, the shipping date (and, in some instances, a pickup time).

The Office Action seems to be asserting, however, that because there may be an intervening step between an input of a shipping date and the calculation of a shipping rate, the shipping rate is therefore not calculated "according to" a shipping date. However, that assertion is inconsistent with, and conflicts with, the ordinary dictionary definition of the term "according."

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In particular, the dictionary definition of the term "according" is "accordingly," and the dictionary definition of the term "accordingly" is "[i]n natural sequence; consequently ...." *Webster's New International Dictionary, Unabridged*; Second Edition; G.&C. Merriam Company; Springfield, Mass.; 1936. It is respectfully submitted that the dictionary definition of the claimed term "according" does not preclude the possibility of intervening steps in a natural sequence of determinations, such as the determination of an ultimate result (*e.g.*, a shipping rate) that is consequent to a determination of an intervening result (*e.g.*, a delivery date), that is immediately consequent to, and a result of a determination in view of, an initial input (*e.g.*, a shipping date).

Even so, independent Claim 64, for example, has been amended to more distinctly claim the claimed invention. In particular, independent Claim 64 has been amended to claim determining a shipping rates and corresponding target delivery dates according to the user's single input of an identification of the particular destination, a set of package specifications for the particular package that is to be delivered to the particular destination, and an indication of a shipping date.

B.   NO COMBINATION OF THE CITED REFERENCE DISCLOSES DETERMINING, ACCORDING TO A USER'S SINGLE INPUT OF A PARTICULAR DESTINATION, PACKAGE SPECIFICATIONS AND A SHIPPING DATE, MULTIPLE DELIVERY SERVICE/ MULTIPLE CARRIER DELIVERY DATES AND CORRESPONDING SHIPPING RATES AS REQUIRED BY AMENDED CLAIM 64 AND ITS DEPENDENT CLAIMS.

Amended independent Claim 64 claims determining shipping rates and corresponding target delivery dates, for multiple delivery services by multiple carriers, to deliver a package to a particular destination, according to a "a user input "of an identification of the particular destination, a set of package specifications for the particular package that is to be delivered to the particular destination, and an indication of a shipping date. *See also, e.g.,* Claim 80 (dependent on Claim 74). It is respectfully asserted that the claimed limitation "a user input" provides that the user makes a single input of the specified criteria, namely, an identification of the particular destination, a set of package specifications, and a shipping date.

The Office Action asserts though, that *UPS* discloses the step of determining a delivery date according to a shipping date. *Office Action*, Topic No. 16, p. 8. In

particular, the Office Action asserts that a user could use the *UPS* reference to "determine the delivery date using the Transit time calculator and discloses considering it when determining a pick up or a drop off time ...." *Office Action*, Topic No. 16, p. 8. The Office Action then further asserts that a user could "... use[ ] the quick cost calculator [of the *UPS* reference] to determine the cost and include Saturday delivery in the cost." The Office Action yet further asserts that "Kara discloses determining the cost to ship UPS ...." *Id.* The Office Action then finally asserts that "... it is the examiner's position that the combination of the two [*UPS* and *Kara*] would disclose the inputted shipping date and the rate calculated according to the input as specified ... in the specification." *Id.*

However, it is respectfully asserted that the aforementioned assertions by the Office Action actually demonstrate that the cited references, even when considered together, do not disclose the limitations claimed, for example, by amended independent Claim 64 for determining shipping rates and corresponding target delivery dates, for multiple delivery services by multiple carriers, to deliver a package to a particular destination, according to "a user input" of an identification of the particular destination, a set of package specifications for the particular package that is to be delivered to the particular destination, and an indication of a shipping date.

First, rather than "a user input" of specific criteria as required by Claim 64, the Office Action describes a number of steps, and consequently, a number of inputs, that a user would have to make, and a number of places (multiple pages in the *UPS* website as well as to *Kara*) that a user would have to go, using the various references cited by the Office Action to get a calculation of a shipping rate and a corresponding target delivery date as required by amended Claim 64.

For example, as compared to determining shipping rates and corresponding target delivery dates, for multiple delivery services by multiple carriers, to deliver a package to a particular destination, according to "a user input" as required by Claim 64, it is respectfully asserted that the *UPS* reference, as well as the archived operational exemplar "Quick Cost Calculator™" page depicted in Exhibit G to the *Bennett Declaration*, appear to indicate that a user would first need to self-determine whether the user's package may be delivered on a Saturday. Then, if the user wants to pay an extra fee for delivery on Saturday, the user would need to self-select the Saturday Delivery

option on the "Quick Cost Calculator™" page in order to self-request a calculation of a rate that would include an extra Saturday delivery charge for the user-selected option for Saturday delivery.

Moreover, as compared to the aforementioned assertions by the Office Action that *UPS* and *Kara* disclose the separate steps of determining a delivery date and then determining a shipping rate according to the delivery date, as instead explained above, the *UPS* "Quick Cost Calculator™" page would have no knowledge of a delivery date. That is, as previously explained above, the *UPS* "Quick Cost Calculator™" page would not know what, if any, delivery date may have been determined in the event that a user had used the *UPS* Time-In-Transit page. Further, the *UPS* "Quick Cost Calculator™" page would calculate a shipping rate without any knowledge of a delivery date. If a user had first determined that the user's package *may* be delivered on a Saturday, then, *if* the user wants to pay an extra fee for delivery on Saturday, the user would need to self-select the Saturday Delivery option on the *UPS* "Quick Cost Calculator™" page – doing so would result in a calculation by the *UPS* "Quick Cost Calculator™" page that would include an extra Saturday delivery charge for the user-selected option for Saturday delivery.

Further, for the reasons given further below, it is respectfully asserted that, as compared to assertions by the Office Action, *Kara* does not disclose the limitations claimed by Claim 64 for "… [d]etermining multiple shipping rates … for a first carrier … [and] [d]etermining multiple shipping rates for a second carrier …" (*Office Action*, Topic Nos. 7.b. and 7.c., p. 3; *Office Action*, Topic Nos. 12.g. and 12.h., p. 5) in response to receiving a user's *single* input (*i.e., "a user input* … comprising … a particular destination, … package specifications for a particular package … and an indication of a shipping date …" (Claim 64; emphasis added). *See also, e.g.,* Claim 74 ("… in response to receiving *an input* by a user … of a particular destination, a particular shipping date and package specifications …" (emphasis added)).

In rejecting Claim 64, the Office Action states that "… Kara discloses … [r]eceiving information from a user such as a set of package specifications (Figure 8, Box 802) and shipping information … (See Figure 8) …." *E.g., Office Action*, Topic No. 5, 5.a, p. 3; *see also Office Action*, Topic Nos. 10, 10.f, p. 5 (regarding rejections of Claims 68-79).

Referring to "Boxes 807 and 808" of Figure 8 of *Kara*, the Office Action then further indicates that *Kara* discloses "… [d]etermining multiple shipping rates … for a first carrier … [and] [d]etermining multiple shipping rates for a second carrier …." *Office Action*, Topic Nos. 7.b. and 7.c., p. 3; *Office Action*, Topic Nos. 12.g. and 12.h., p. 5.

However, it is respectfully asserted that exemplary embodiments of the limitations claimed by the amended Claims, *e.g.*, amended independent Claim 64, regarding determining and displaying, shipping rates and corresponding delivery dates for *multiple delivery services* for multiple carriers in response to a user's *single* input would be useful over the cited references in that such embodiments would facilitate displaying (as claimed, for example, by Claim 64) a convenient cross-comparison of the various shipping rates for various delivery services offered by various carriers so that the user can then, based on the user's evaluation of the shipping rates and the other displayed features, select a particular delivery service for a particular carrier for shipping the user' parcel.

For reasons similar to those given above with respect to Claim 64, it is respectfully asserted that the cited references do not disclose determining and displaying, shipping rates and corresponding delivery dates for *multiple delivery services* for multiple carriers in response to a user's *single* input as required by dependent Claim 80.

For the foregoing reasons, it is therefore respectfully asserted that amended independent Claim 64, and its dependent Claims 65-67, 69-70, and 72, and also Claim 80, are non-obvious in view of, and patentable over, the cited references.

C.   NO COMBINATION OF THE CITED REFERENCES DISCLOSES IDENTIFYING DELIVERY DATES AND TIMES FOR VARIOUS DELIVERY SERVICES FOR VARIOUS CARRIERS IN RESPONSE TO A USER'S SINGLE INPUT AS REQUIRED BY INDEPENDENT CLAIM 74.

Similar to Claim 64 claiming determining shipping rates for multiple delivery services in response to receiving a *single* user input of a destination, package specifications and a shipping date, Claim 74 claims identifying delivery dates and times for various delivery services for various carriers in response to a user's *single* input. For reasons similar to those given above with respect to Claim 64, it is respectfully asserted that the cited references do not disclose identifying various dates and times for various

delivery services for various carriers in response to a user's single input as required by amended Claim 74.

The Office Action asserts that "[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day ...." *Office Action*, Topic No. 13, p. 6.

However, it is respectfully asserted that the asserted disclosure of the *UPS* and *FedEx* references as posited by the Office Action of "... specific services where they are guaranteed delivery by a certain time in the day ..." (*Office Action*, Topic No. 13, p. 6) fails to assert disclosure of the claimed limitations for identifying delivery dates and times for various services for various carriers, according to and in response to, a user's single input of, among other things, a particular shipping date as claimed by dependent Claim 69 and amended independent Claim 74.

For the above-given reasons, it is therefore respectfully asserted that amended dependent Claim 69, and amended independent Claim 74, and the Claims dependent on it, namely, Claims 75, 77, and 80-81, are non-obvious in view of the cited references and are therefore in condition for allowance.

D. **INTERSHIPPER FAILS TO DISCLOSE A SIMULTANEOUS DISPLAY OF RATES FOR MULTIPLE DELIVERY SERVICES PROVIDED BY VARIOUS CARRIERS, AND IT WOULD BE IMPROPER TO READ INTO INTERSHIPPER A PRESUMPTION OF SUCH A SIMULTANEOUS DISPLAY OF RATES THAT IS GLEANED FROM THE PRESENT APPLICATION.**

For the following reasons and authorities, it is respectfully asserted that the combination of limitations claimed by independent Claim 64 is nonobvious in view of the combination of *Intershipper* with the other cited references, because *InterShipper*, even when considered in combination with any of the other cited references, fails to disclose, anticipate, teach or suggest a simultaneous display of shipping rates and delivery times for various delivery services by various carriers as claimed by independent Claim 64.

The Office Action concedes that "Kara ... fails to disclose the simultaneous display of rates for each carrier that includes rates of different services (Column 11, lines 1-13)" (*Office Action*, Topic No. 8, p. 4; *Office Action*, Topic No. 13, pgs. 5-6), but asserts that *InterShipper* does. *Office Action*, Topic No. 8, p. 4 (stating that "Intershipper is an

internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3)." *See also, e.g., Office Action*, Topic No. 13, p. 6. The Office Action concedes that "[t]he InterShipper article may not explicitly disclose that the results are displayed on a computer screen ...," but asserts that "... InterShipper discloses all the information being given at one time." *Office Action*, Topic No. 20, p. 10.

First, contrary to the inference apparently asserted by the Office Action that the *InterShipper* reference discloses rates for multiple delivery services offered by multiple carriers in its results, it is respectfully asserted that the *InterShipper* reference never states that the *InterShipper* service would include *various delivery services* offered by the "major shippers." To the contrary, the *InterShipper* reference only states that "Internet users can now get shipping rates from all major shippers ...."

Further, it is respectfully asserted that the mention by the *InterShipper* reference that "[t]he free service will return every method possible that you can use to ship your package ..." (*InterShipper*, p. 1, ¶2) does not expressly state that the *InterShipper* reference would report a rate for various delivery services for various carriers. Rather, it is respectfully asserted that "every method possible" could be interpreted to merely refer to "all major shippers" as expressly mentioned by the *InterShipper* reference.

Yet further, the Office Action is apparently asserting that the below-quoted statements should be inferred to indicate that the *InterShipper* reference simultaneously displayed ("all at one time" (*Office Action*, Topic No. 20, p. 10)) its results:

> Internet users can now get shipping rates from all major shippers in just a few seconds. Simply enter your origin, anywhere in the U.S. is OK, and destination, worldwide, along with your package weight and dimensions. The free service will return every method possible that you can use to ship your package and arrange the results in cost order, and color code the results by approximate transit time. World Wide Web: http//www.wwmerchant.com/iship.

InterShipper, p. 1, ¶2.

However, for the reasons given and under the authorities cited below, it is respectfully asserted that the inference is misplaced and unsupported.

Importantly, the cited *InterShipper* reference is a publication, not a U.S. patent. As such, there is no presumption of enablement as to the disclosure of the cited *InterShipper* reference. Moreover, as to the Claims of the present application, it is respectfully asserted that the cited *InterShipper* reference is not enabling.

Although the cited *InterShipper* reference may qualify as a prior art reference under Section 103, it may only be used as a prior art reference "… for what is in fact disclosed in it." *Reading and Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 652 (Fed. Cir. 1984) (finding a non-enabling promotional brochure cannot be used as a vehicle for qualifying a later filed patent as prior art).

Under *Reading and Bates*, it is respectfully asserted that, contrary to the above-mentioned inferences apparently asserted by the Office Action, the *InterShipper* reference never states that the *InterShipper* service would display its results simultaneously, or "all … at one time" or that *InterShipper* would display rates for various delivery services offered by various major shippers, as apparently asserted by the Office Action (*Office Action*, Topic No. 20, p. 10). Rather, the *InterShipper* reference states only that "Internet users can now get shipping rates from all major shippers … [t]he free service will return every method possible that you can use to ship your package …." *InterShipper*, p. 1, ¶2. It does not state that the display will include various delivery services by various major shippers; it does not say that such returned "every method possible" will be simultaneously displayed; and it does not even say that such returned "every method possible" will be displayed "all … at one time" as asserted by the Office Action (*Office Action*, Topic No. 20, p. 10).

The Office Action posits that "it is clear that the results are returned all at once, because they are color coded and arranged in cost order and transit time." *Office Action,* Topic No. 20, p. 10.

Contrary to the Office Action's interpretation of the statement by *InterShipper* that the results will be arranged in cost order, and color coded, it is respectfully asserted that the statement merely indicates that before display, the *InterShipper* reference discloses a pre-display evaluation (and an arrangement and color-coding) of the results. It does not state that the results are displayed simultaneously so that a user would see every result all at one time. Instead, it is respectfully asserted that a single-result-per-screen display

could present a first, color-coded result on a first screen, and then present subsequently ordered, differently colored results on respective subsequent screens.

Rather, it is respectfully asserted that the reading of *InterShipper* posited by the Office Action is one that is based on a perspective gleaned from the present application as proscribed by the Federal Circuit in *In re Mahurkar*. Cf. *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. III. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

Because the Office Action relied on the *InterShipper* reference to provide the conceded missing link of a simultaneous display absent from the *Kara* reference, in view of the holdings of *In re Mahurkar* and *Reading and Bates*, it is therefore respectfully asserted that the complete absence from the *InterShipper* reference of any statement that the *InterShipper* service will display its results simultaneously, or even that it will return its results "all … at one time" as suggested by the Office Action, and the complete absence from the *InterShipper* reference of an express statement that the *InterShipper* service would include various delivery services offered by the "major shippers" as further suggested by the Office Action, is evidence that the combinations of limitations of Claim 64, and therefore its dependent Claims 65-67, 69-70 and 72, of the present application, are therefore non-obvious in view of the *InterShipper* reference, even when that reference is considered in combination with the other cited references.

E.   **NO COMBINATION OF THE CITED REFERENCES DISCLOSES SIMULTANEOUSLY DISPLAYING CALCULATED RATES IN ASSOCIATION WITH CORRESPONDING DELIVERY SCHEDULE INDICIA, SUCH AS DELIVERY DATES AND TIMES, FOR VARIOUS DELIVERY SERVICES OFFERED BY VARIOUS CARRIERS.**

It is respectfully asserted that *Barnett* fails to disclose the display of any rates, and the other cited references fail to disclose the display of rates with any association with corresponding delivery dates and times. Therefore, it is respectfully asserted that the position of the Office Action that it would have been obvious to use the graphical representation of *Barnett* of date on one axis and time on another for the display of shipping rates is not a proper combination as required under MPEP §706.02(j) and MPEP §2143.

For the above-given reason and authorities, it is respectfully asserted that the limitations of the Claims of the present application are not disclosed, anticipated, taught or suggested by any of the cited references, whether considered alone or in combination with any other cited reference, and are therefore non-obvious in view of the cited references, and are therefore in condition for allowance.

F.   THE COMBINATIONS OF LIMITATIONS CLAIMED BY THE REJECTED CLAIMS YIELD MORE THAN A SEPARATE APPLICATION BY THE CLAIMED ELEMENTS AND ARE THEREFORE PATENTABLE UNDER KSR.

Further, it is respectfully asserted that the combinations of limitations claimed by the rejected Claims meet the *KSR* test for non-obviousness.

In *KSR*, the Supreme Court acknowledged that "… inventions in most, if not all, instances, rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR*, 127 S.Ct. at 1741. Accordingly, the *KSR* Court reiterated its caution against hindsight bias and *ex post* reasoning. *KSR*, 127 S.Ct. at 1742. *Accord Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 2008 U.S. App. LEXIS 6786, *14-*15 (Fed. Cir. March 31, 2008) (explaining that "a flexible TSM [teaching, suggestion, or motivation] test remains the primary guarantor against a non-statutory hindsight analysis …."(citations omitted)).

"[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR*, 127 S.Ct. at 1741. Rather, the *KSR* Court clarified ways in which a claim could be shown to be nonobvious. In particular, the *KSR* Court indicated that combining known elements so that the combination yields more than one would expect from such an arrangement would support nonobviousness. *Cf., KSR* at 1740.

In accordance with the above-outlined *KSR* approach for supporting nonobviousness, it is respectfully asserted that the combination of limitations claimed by, for example, amended independent Claims 64 and 74 yield more than a separate application of the claimed elements.

In particular, it is respectfully asserted that exemplary embodiments of the limitations claimed by the amended Claims, *e.g.*, amended independent Claim 64 and

dependent Claim 80, regarding determining and displaying, shipping rates for *multiple delivery services* for multiple carriers in response to a user's *single* input would be useful over the cited references in that such embodiments would facilitate displaying (as claimed, for example, by Claims 64 and 81) a convenient cross-comparison of the various shipping rates for various delivery services offered by various carriers so that the user can then, based on the user's evaluation of the shipping rates and the other displayed features, select a particular delivery service for a particular carrier for shipping the user' parcel.

For similar reasons, it is respectfully asserted that exemplary embodiments of the limitations claimed by, *e.g.*, amended independent Claim 74, regarding determining and displaying, delivery dates and times for *multiple delivery services* for multiple carriers in response to a user's *single* input would be useful over the cited references in that such embodiments would facilitate displaying a convenient cross-comparison of the various delivery schedule features for various delivery services offered by various carriers, so that a user would be able to evaluate the various delivery schedule features side-by-side and choose a delivery service by a particular carrier that would meet the user's timing needs for a particular shipment.

For the above-given reasons, it is therefore respectfully asserted that Claims 64, and 74, and therefore their dependent claims, namely, Claims 65-67, 69-70, 72, 75, 77, and 80-81, are non-obvious in view of the cited references and are therefore in condition for allowance.

Conclusion

For the foregoing reasons and authorities, it is respectfully asserted that the invention disclosed and claimed by the Claims of the present application are not fairly taught by any of the cited references, taken either alone or in combination, are distinguished from, are not obvious in view of, and are therefore patentable over, the cited references. Accordingly, it is respectfully asserted that the application is condition

for allowance. Accordingly, reconsideration and allowance of the Claims of the present application are respectfully requested.

Respectfully submitted,
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